

REMARKS

Claims 2-9, 12, 13 and 25 presently appear in this case. No claims have been allowed. The official action of December 4, 2002, has now been carefully studied. Reconsideration and allowance of this case are respectfully urged.

Briefly, the present invention relates to a peptide corresponding to positions 89-96 of the human C-reactive protein (CRP) of the formula: Val₈₉-Thr-Val-Ala-Pro-Val-His-Ile₉₆ and modifications thereof obtained by substitution, elongation and amidation of the C-terminal or acylation of the N-terminal. The present peptides do not encompass the entire CRP. These peptides may be used to inhibit the enzymatic activity of human Leukocyte Elastase (hLE) and/or of human Leukocyte Cathepsin G (hCG) and can be used for the treatment of chronic inflammation conditions such as rheumatoid arthritis, pulmonary emphysema and cystic fibrosis.

The examiner has objected to claim 25 because of an informality, the examiner suggesting that a comma be inserted after "Ile" in the proviso clause.

Claim 25 has now been amended as suggested by the examiner, thus obviating this objection.

Claims 2-9, 12, 13 and 25 have been rejected under 35 U.S.C. §112, first paragraph, as containing subject matter

which was not described in the specification. The examiner states that newly-added claim 25 contains new matter because of the recitation about the proviso, stating that this proviso is not supported by the original disclosure. This rejection is respectfully traversed.

In order to understand why there is written description support for the proviso in claim 25, the examiner's attention is invited to the attached claim exhibits, containing claim exhibits A-G. At the present time these are being presented for discussion purposes only. Claim A is the same as claim 25, except that the proviso reads "with the proviso that the residue at 89 is not Leu". For the following reasons, it is believed that the examiner must concede that claim exhibit A, if presented, would be fully supported by the specification so as to comply with the written description requirement of 35 U.S.C. §112. If a genus is disclosed in the specification, including a number of specific species, then that genus excluding one of the specified species also satisfies the written description requirement. The case of *In re Johnson*, 194 USPQ 187, 196 (1977) is directly in point where it states:

The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirement of 112, first paragraph, appears

to result from a hypertechnical application of legalistic prose relating to that provision of the statute. All that happened here is that appellants narrowed their claims to avoid having them read on a lost interference count.

See also MPEP §2173.05(i), which states:

If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 178, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining.").

That the hydrophobic residue at position 89 may be Leu is disclosed in the present specification in the first paragraph of page 6. Thus, if the entire genus is disclosed, specifically including the species in which the residue at position 89 is Leu, then the entire genus is also disclosed minus the species in which the residue at position 89 is Leu. Barr requires that the residue corresponding to position 89 be Leu. Claim exhibit A, therefore, is not anticipated by Barr and, in light of *In re Johnson*, is supported in the sense of the written description requirement of 35 U.S.C. §112. Thus, it is urged that the examiner must concede that were claim exhibit A to be presented in the case, it would be allowable as it is not anticipated by Barr and it is supported by the written description of the present specification.

Similarly, claim exhibit B is the same as claim 25, except that the proviso reads, "with the proviso that the

residue at 90 is not Glu". The present specification supports the presence of Glu at position 90 on page 6, lines 20 and 21. Thus, as the genus with this species is disclosed, the genus without it must also be disclosed for the same reasons as discussed above with respect to claim exhibit A. Accordingly, if claim exhibit B were of record in this case, it would also have to be allowable as Barr requires that the residue at 90 be Glu and the claim is supported by the written description.

It should be noted that claim exhibit A permits the residue at position 90 to be Glu, and claim exhibit B permits the residue at position 89 to be Leu. Thus, between claim exhibits A and B, the only species which is not covered by one or the other of the claims is one in which the residue at position 89 is not Leu and the residue at position 90 is not Glu, both at the same time.

It can readily be seen that the same arguments are applicable to claim exhibits C, D, E, F and G. Each of these claims must be considered to comply with the written description requirement and to avoid anticipation by Barr. The cumulative effect of these seven independent claims is to cover every species within the claimed genus except for the species in which the residue at position 89 is Leu, the residue at position 90 is Glu, the residue at position 91 is Ala, the residue at position 92 is Ile, the residue at

position 94 is Val or Ala, the residue at position 95 is Ser, and the residue at position 96 is Ile, all at the same time. Thus, if all of the seven independent claims of claim exhibits A-G were submitted, the cumulative effect would be exactly identical to the scope of presently amended claim 25, which does it all in one claim. If there is written description support for the cumulative exclusions of claim exhibits A-G, then there must be written description support for the shorthand version thereof in claim 25. To hold otherwise would appear "to result from a hypertechnical application of legalistic prose relating to that provision of the statute" (*In re Johnson, supra*). All that is happening here is that applicants are narrowing their claim to avoid having it read on a prior art reference found by the examiner.

Accordingly, it is requested that the examiner reconsider this rejection and withdraw it for the reasons explained herein. The statute does not require that applicants go to the expense of submitting seven independent claims and corresponding sets of dependent claims when the exact same effect can be had by filing a single claim and a single set of dependent claims. As discussed above, as there is support for each of the seven independent claims of claim exhibits A-G and the cumulative effect of these seven claims is exactly the same as the scope of claim 25, there is no good

reason not to hold that claim 25 also complies with the written description requirement of 35 U.S.C. §112.

Claims 2, 3 and 25 have been rejected under 35 U.S.C. §102(b) as being anticipated by Barr. The examiner points out that claim 25 does not exclude the residue at position 94 being Ala, while this is one of the variants disclosed by Barr. Thus, claim 25 is anticipated.

The examiner is correct. Applicants inadvertently failed to exclude the situation where the residue at position 94 is Ala when all of the other residues are the same as those in Barr. This error has now been corrected by amending claim 25 to specify that the residue at position 94 is not either Val or Ala, at the same time that all of the other residues are as specified. With this correction, claim 25 is no longer anticipated by Barr, nor is any dependent claim. Reconsideration and withdrawal of this rejection are, therefore, respectfully urged.

Claims 9, 12 and 13 have been rejected under 35 U.S.C. §103(a) as unpatentable over Barr. This rejection is respectfully traversed.

As discussed above, claim 25 has now been amended to correct an inadvertent omission and clarify that the specified generic sequence does not encompass either sequence disclosed by Barr. As the formula does not encompass Barr and the

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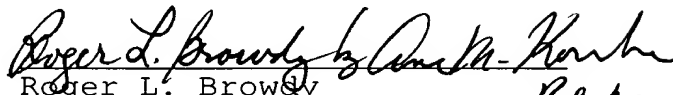
examiner does not take the position that Barr makes obvious any other sequences, it would not be obvious to use any of these novel sequences in any manner. Accordingly, reconsideration and withdrawal of this rejection are also respectfully urged.

It is submitted that all the claims now present in the case clearly define over the references of record and fully comply with 35 U.S.C. §112. Reconsideration and allowance are, therefore, earnestly solicited.

Respectfully submitted,

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